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No. 83-1647

IN THE

Supreme Court of the United States

October Term, 1983

LINDY PEN COMPANY, INC. and
BLACKFEET PLASTICS, INC.,
Petitioners,

vs.

BIC PEN CORPORATION,
Respondent.

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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June 4, 1984

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Counter Statement of the Questions Presented

(a) This case does not present any question for review with respect to the decision of the Ninth Circuit Court of Appeals on the assertion that the Court defeated the trademark registrant's right to offensive use of incontestability under the Lanham Act on the ground that the registered trademark lacked secondary meaning rendering it invalid or unenforceable;

(b) The basis for the Ninth Circuit's decision was not that the mark was invalid even though incontestable under the statute; not that the mark was invalid or unenforceable because it lacked secondary meaning even though incontestable; but that, irrespective of any issue of incontestability, the mark was valid but there was no infringement because Respondent's use was *not* one which was "likely to cause confusion, or to cause mistake, or to deceive" as required by Section 32 of the Lanham Act, 15 U.S.C. §1114(a);

(c) The Ninth Circuit's holding that there can be no liability for trademark infringement. under the Lanham Act, unless there is likelihood of confusion, is in uniformity with the law in all circuits and presents no conflict; and

(d) The issue of incontestability, the crux of the question before this Court in the *Park 'N Fly* case, did not affect the outcome of the Ninth Circuit's decision and, accordingly, is not a proper question for review in this case before this Court.

The Parties

Pursuant to Supreme Court Rule 28.1, Respondent Bic Pen Corporation (hereinafter referred to as "Bic"), which changed its name to Bic Corporation on May 24, 1982, identifies its parent company as Societé Bic S.A., which owns approximately 57% of the stock of Bic Corporation; and identifies its subsidiaries (except wholly owned subsidiaries) as: Carbide Alloys, Inc., Caribus Products Ltd., Indeta Instrumentos Descartables C.A., and Productos Adhesivos C.A.

Petitioners are the Lindy Pen Company, Inc. and Blackfeet Plastics, Inc. (hereinafter referred to as "Lindy").

TABLE OF CONTENTS

	PAGE
COUNTER STATEMENT OF THE QUESTIONS PRESENTED	I
THE PARTIES	II
I. COUNTER STATEMENT OF THE CASE	1
II. OPINIONS BELOW	4
III. STATUTES INVOLVED	4
IV. THE DISTRICT COURT	5
V. THE NINTH CIRCUIT	7
VI. REASONS FOR DENIAL OF PETITION	9
A. The Ninth Circuit Found and Concluded That There Was No Likelihood of Confusion	9
B. Consolidation With *Park 'N Fly* Is Academic	11
VII. CONCLUSION	13

TABLE OF AUTHORITIES

PAGE

Cases:

AMP Inc. v. Foy, 540 F.2d 1181 (4th Cir. 1976) 10

Armstrong Cork Co. v. World Carpets, Inc., 198 U.S.P.Q. 526 (N.D. Ga. 1977) 11

Beef/Eater Restaurants, Inc. v. James Burrough Ltd., 398 F.2d 637 (5th Cir. 1968) 10

Beer Nuts, Inc. v. Clover Club Foods Company, 711 F.2d 934 (10th Cir. 1983) ..... 9, *passim*

Communications Satellite Corp. v. Comcet, Inc., 429 F.2d 1245 (4th Cir. 1970) 10

David Sherman Corp. v. Heublein, Inc., 340 F.2d 377 (8th Cir. 1965) 9

Esquire, Inc. v. Esquire Slipper Manufacturing Co., 243 F.2d 540 (1st Cir. 1957) 10

Exquisite Form Industries, Inc. v. Exquisite Fabrics of London, 378 F.Supp. 403 (S.D.N.Y. 1974) 11

Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149 (9th Cir. 1963) ..... 9, *passim*

Grotrian, Helfferich, Schulz, Etc. v. Steinway & Sons, 523 F.2d 1331 (2d Cir. 1975) 10

HMH Publishing Co., Inc. v. Brincat, 504 F.2d 713 (9th Cir. 1974) 10

Hanson v. Triangle Publications, 163 F.2d 74 (8th Cir. 1947) 10

Henri's Food Products Company, Inc. v. Kraft Inc., 717 F.2d 352 (7th Cir. 1983) 11

Hyatt Corporation v. Hyatt Legal Services, No. 82-C-6178, slip op. (N.D. Ill. April 5, 1983) 11

PAGE

James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266 (7th Cir. 1976) 10
Johnson Publishing Co., Inc. v. Etched-In-Ebony, Inc., 213 U.S.P.Q. 995 (D.D.C. 1981) 11

McLean v. Flemming, 96 U.S. 245 (1877) 9

Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 718 F.2d 327 (9th Cir. 1983), *cert. granted*, 52 U.S.L.W. 3650 (U.S. March 5, 1984) (No. 83-1132) ..... 1, *passim*
Park 'N Fly, Inc. v. Park & Fly, Inc., 489 F.Supp. 422 (D. Mass. 1979) ..... 1, *passim*
Playboy Enterprises, Inc. v. Chuckleberry Publishing, Inc., 486 F.Supp. 414 (S.D.N.Y. 1980) 10

S.C. Johnson & Son, Inc. v. Johnson, 266 F.2d 129 (6th Cir. 1959) 10
Safeway Stores, Inc. v. Safeway Properties, Inc., 307 F.2d 495 (2d Cir. 1962) 9
Standard Oil Co. of New Mexico v. Standard Oil Co. of Cal., 56 F.2d 973 (10th Cir. 1932) 10
Sun-Maid Raisin Growers of California v. Sunaid Food Products, Inc., 356 F.2d 467 (5th Cir. 1966) 11

Tisch Hotels, Inc. v. Americana Inn, Inc., 350 F.2d 609 (7th Cir. 1965) 10
Triangle Publications, Inc. v. Standard Plastic Products, Inc., 241 F.Supp. 613 (E.D. Pa. 1965) 10

Waterman-Bic Pen Corporation v. Beisinger Industries Corp., 321 F.Supp. 178 (S.D.N.Y. 1970) 3
World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482 (5th Cir. 1971) 10

Ye Olde Tavern Cheese Products, Inc. v. Planters Peanuts Div., 261 F.Supp. 200 (N.D. Ill. 1966), *aff'd*, 394 F.2d 833 (7th Cir. 1967) 11

PAGE

Statutes:

15 U.S.C. §1065 12
15 U.S.C. §1114(a) ..... 3, *passim*
15 U.S.C. §1115 ..... 9, *passim*

Other Authorities:

2 J. McCarthy, Trademarks and Unfair Competition, §23.1 (1973) 9
Restatement of Torts §731 (1938) 9

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OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

I. Counter Statement of the Case

Petitioners incorrectly view the Ninth Circuit decision below as hinging on the same issue, incontestability of a trademark, which is the central issue before this Court in *Park 'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 718 F.2d 327 (9th Cir. 1983), *cert. granted*, 52 U.S.L.W. 3650 (U.S. March 5, 1984) (No. 83-1132). That case concerns the trademark PARK 'N FLY whose *validity and enforceability* on the basis of incontestability were upheld in a First Circuit District Court, *Park 'N Fly, Inc.* v. *Park & Fly, Inc.*, 489

F.Supp. 422 (D. Mass. 1979), while held invalid and unenforceable, even though incontestable under the trademark statute, in the Ninth Circuit, *Park 'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 718 F.2d 327 (9th Cir. 1983) (hereinafter referred to as "Park 'N Fly").

The issue of incontestability, the sole issue sought to be presented here by Petitioners, had, on the other hand, no impact upon the final outcome of both the District Court and Court of Appeals decisions in the present case. Both decisions were based on the Court's careful consideration of "foundational factors," recognized by all the federal circuits as necessary to consider in determining the ultimate question in all trademark infringement cases, likelihood of confusion (A3-5).[1] Both the District Court and the Ninth Circuit found that the foundational factors *could not* support a finding of "likelihood of confusion" (A11). Whether Lindy's AUDITOR'S trademark was incontestable had no effect upon this finding.

Incontestability affects the issue of whether the trademark is valid and hence enforceable, not the issue of infringement. As the Ninth Circuit succinctly stated, "there could be no liability for trademark infringement, even where the mark has attained incontestable status, in the absence of likelihood of confusion" (A13).

Petitioners' attempt to create the appearance that the issue of incontestability is similar to the issues in *Park 'N Fly* and is pivotal to the ultimate decision in the present case, plainly and simply lacks any substance.

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1. The term "A—" refers to the page of the Appendices to Lindy's Petition for Writ of Certiorari.

In the present case there is no conflict between any circuits with respect to the validity and enforceability of Lindy's trademark AUDITOR'S. Both the District Court and the Court of Appeals found and applied the trademark as *valid,* without reference to whether it was incontestable or not. Unlike the situation presented in *Park 'N Fly,* in the instant case the Ninth Circuit, as well as the District Court, recognized that Lindy's trademark was valid and, therefore, represented a proprietary right which, if the facts warranted, could be infringed. The Ninth Circuit recognized that right in remanding the case to the District Court to make a determination as to whether a likelihood of confusion did or did not exist in the limited market of telephone sales.[2]

The unique factual issues presented here, which include Respondent's predominant use of the famous name BIC to identify its products[3] and the complete lack of actual confusion and likelihood of confusion in the marketplace, make this case one which turns on the facts as applied to the trademark infringement statute, 15 U.S.C. §1114(a), which requires a finding of likelihood of confusion to support a claim of infringement. A question of law is truly not involved.

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2. The remand to the District Court is pending and the parties have not yet filed their respective Proposed Findings of Fact and Conclusions of Law.

3. That the mark and name BIC is synonymous with, among other things, ball point pens was *judicially* acknowledged fourteen years ago in *Waterman-Bic Pen Corporation* v. *Beisinger Industries Corp.,* 321 F.Supp. 178, 179 (S.D.N.Y. 1970):

> "Plaintiffs are the manufacturers and distributors of the BIC pen; they have established in some fifteen years a position as the leading ball point pen producer and *the term 'BIC' is a household expression for the ball point pen.*" (Emphasis supplied).

There is no question of law in this case, a review of which by this Court could result in a different determination. Even if the question presented by the Petition were to be determined favorably to Petitioners, the determination of noninfringment based upon the lack of likelihood of confusion would remain unchanged.

II. Opinions Below

The Opinions of the United States Court of Appeals for the Ninth Circuit and the United States District Court for the Central District of California attached to Lindy's Petition for Writ of Certiorari as Appendices A and B respectively are incorporated herein by reference.

III. Statutes Involved

Contrary to Petitioners' statement, the only statute involved is 15 U.S.C. §1114(a), which provides in full as follows:

"§1114. Remedies—Infringement

(a) Any person who shall, without the consent of the registrant—

(1) use in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or *in connection with which such use is likely to cause confusion,* or *to cause mistake,* or *to deceive;* or

(2) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduc-

> tion, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use *is likely to cause confusion,* or *to cause mistake,* or *to deceive;*
>
> shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) of this section, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake or to deceive." (Emphasis supplied).[4]

(July 5, 1946, c. 540, Title VI, §32, 60 Stat. 437; October 9, 1962, Public Law 87-772, §17, 76 Stat 773.)

IV. The District Court

Lindy brought this trademark infringement action in the United States District Court for the Central District of California in 1980. After a bench trial, between June 22, 1982 and July 1, 1982, involving over 600 exhibits and the testimony of 12 witnesses for Lindy and 3 witnesses for Bic, the District Court found and concluded that Lindy's AUDITOR'S trademark was valid but that Lindy had failed in its burden to show that there was a likelihood of confusion between Bic's use of the legend "Auditor's Fine Point" on its fine point pens sold to the commercial trade and Lindy's trademark AUDITOR'S as applied to Lindy's fine point pens sold to the retail trade.

4. The District Court found, and such finding was affirmed by the Court of Appeals, that "Bic adopted the designation 'Auditor's fine point' without intent to capitalize on Lindy's mark" (A4).

The Court reached its determination that there was no likelihood of confusion after considering the facts with respect to the elements that courts must consider in determining whether confusion as to origin, source or sponsorship is likely. The District Court found that Lindy's mark was weak (FF19),[5] that Lindy's pens are prominently identified by the trademark and name LINDY (FF19), that the packaging and collateral promotional materials of the parties prominently, repeatedly and respectively display the trademark and names BIC and LINDY (FF15),[6] that the pens, packaging and collateral display material are distinguishable and are dissimilar in graphics and textual content (FF14), that Bic uses the term Auditor's in conjunction with other words (Fine Point) and with the BIC trademark (FF20), that there was no showing of even a single instance of actual confusion in connection with the sale of millions of pens (FF21), that considering the marks and names in their entirety and as they appear in the marketplace, the marks are not similar (FF20), that purchasers of both Lindy's and Bic's pens exercise ordinary care (FF25), that Bic had no intent to capitalize on Lindy's mark (FF23) and that the parties' pens are generally not sold in the same channel of trade (FF22).

The District Court addressed the issue of incontestability, not as to validity of the mark but only as it concerned

5. "FF—" refers to numbered Findings of Fact appearing in the District Court opinion, Appendix B to Lindy's Petition.

6. The District Court specifically recognized in FF15:

> "The trademarks and names BIC and LINDY are prominently and repeatedly displayed on the parties' respective packaging and collateral promotional materials so as to avoid any likelihood of confusion, mistake or deception as to source, sponsorship or origin."

defendant's defense of "fair use"—that defendant used the term "Auditor's Fine Point" fairly and in good faith to describe the model type of the pen or the class of user for whom the pen is suited.[7] Incontestability did not enter into the analysis of likelihood of confusion. [Compare District Court opinion Section II entitled "Trademark Infringement, Unfair Competition and False Designation of Origin" (A24-A26) with Section III entitled "Incontestability" (A26-27)].

V. The Ninth Circuit

The Ninth Circuit upheld the District Court's finding of no likelihood of confusion based on its analysis of the foundational factors in the general consumer and commercial marketplace. As noted by Petitioners, the Ninth Circuit "agreed that Lindy's trademark AUDITOR'S is valid and incontestable" (Petition at 9). As stated by the Ninth Circuit at A4 and A5:

> "The district court found that 'Auditor's' was a weak mark, that there was no evidence of actual confusion, that Bic adopted the designation 'Auditor's fine point' without intent to capitalize on Lindy's mark and that, although the pens were inexpensive, Lindy had made no showing that purchasers failed to exercise ordinary caution. None of these findings is clearly erroneous. The record indicates that a number of competing pen manufacturers had used or were using 'Auditor's' to designate fine point pens at the time Lindy adopted the word as a trademark. Prior to

7. The District Court did not discuss secondary meaning as affecting in any way the incontestability of the trademark AUDITOR'S but instead discussed secondary meaning as an isolated "Additional Conclusion of Law" in Conclusion of Law 12 (A29).

> selecting 'Auditor's' to designate its PF pen, Bic determined that several brands of pens advertised 'auditor's point' or 'auditor's extra fine point' pens. Bic elicited testimony from Lindy's witnesses that 'Auditor's' indicated a pen with an extra fine point. Lindy introduced no evidence of actual confusion and no testimony indicating purchaser carelessness."

The Ninth Circuit continued at A11:

> "We now turn to the district court's conclusion that Bic's use of the word 'Auditor's' on its PF pens creates no likelihood of confusion. On the basis of the record before us, we have no difficulty affirming the district court's conclusion that Lindy has failed to show a likelihood of confusion with respect to retail over-the-counter sales, mail order sales and sales by the manufacturer to intermediaries."

The Ninth Circuit then vacated the District Court's determination only with respect to the limited market of telephone sales and remanded for further findings.[8]

Consequently, as with the District Court, the incontestability of Lindy's trademark AUDITOR'S, and the sword/shield, offensive/defensive dichotomy did not enter into the calculus of whether there was trademark infringement, i.e., a likelihood of confusion. The underlying factors, upon which the entire Ninth Circuit decision is based, were unaffected by the status of Lindy's mark. The incontestability of the trademark was only relevant to Bic's alternative de-

8. Although the Ninth Circuit upheld the District Court's finding that the trademark AUDITOR'S in fact lacked secondary meaning (A10), the Court treated the mark as if it had secondary meaning, for otherwise there would have been no reason to remand the case to the District Court for further detailed findings on whether there was or was not a likelihood of confusion in the telephone sales market.

fense of "fair use," one of the enumerated defenses under the incontestability statute, 15 U.S.C. §1115, a defense which the Court determined adversely to Bic. The Court's consideration of this defense inherently had to be based upon an assumption that the mark was incontestable.

VI. Reasons for Denial of Petition

A. The Ninth Circuit Found and Concluded That There Was No Likelihood of Confusion

The keystone of trademark infringement in the United States is whether the defendant has created a "likelihood of confusion." *See McLean* v. *Flemming,* 96 U.S. 245 (1877); *Safeway Stores, Inc* v. *Safeway Properties, Inc.,* 307 F.2d 495 (2d Cir. 1962); *David Sherman Corp.* v. *Heublein, Inc.,* 340 F.2d 377 (8th Cir. 1965); *Fleischmann Distilling Corp.* v. *Maier Brewing Co.,* 314 F.2d 149 (9th Cir. 1963); 2 J. McCarthy, Trademarks and Unfair Competition, §23.1 (1973). In determining whether confusion is likely, the courts generally look at several foundational factors. *See Beer Nuts, Inc.* v. *Clover Club Foods Co.,* 711 F.2d 934, 940 (10th Cir. 1983) and cases cited therein; Restatement of Torts §731 (1938). The Ninth Circuit in the present case addressed each of the factors at A '':

> "We treat a determination of the likelihood of confusion as a conclusion of law premised on an analysis of a number of subsidiary factors, including the strength of plaintiff's mark, the similarity of the marks, the similarity of plaintiff's and defendant's goods and the proximity of their marketing channels, evidence of actual confusion, defendant's intent in selecting the mark, the type of goods and the degree of care exer-

cised by purchasers. *See Carson Manufacturing Co.* v. *Carsonite International Corporation,* 686 F.2d at 670-71."

That the analysis of all such factors applies to both likelihood of confusion as to source or origin and likelihood of confusion as to association or sponsorship is well recognized.[9] *See HMH Publishing Co., Inc.* v. *Brincat,* 504 F.2d 713, 717 (9th Cir. 1974). *See also Playboy Enterprises, Inc.* v. *Chuckleberry Publishing, Inc.,* 486 F.Supp. 414 (S.D.N.Y. 1980); *AMP Inc.* v. *Foy,* 540 F.2d 1181 (4th Cir. 1976); *James Burrough Ltd.* v. *Sign of Beefeater, Inc.,* 540 F.2d 266 (7th Cir. 1976); *Grotrian, Helfferich, Schulz, Etc.* v. *Steinway & Sons,* 523 F.2d 1331 (2d Cir. 1975); *World Carpets, Inc.* v. *Dick Littrell's New World Carpets,* 438 F.2d 482 (5th Cir. 1971); *Communications Satellite Corp.* v. *Comcet, Inc.,* 429 F.2d 1245 (4th Cir. 1970); *Beef/Eater Restaurants, Inc.* v. *James Burrough Ltd.,* 398 F.2d 637 (5th Cir. 1968); *Tisch Hotels, Inc.* v. *Americana Inn, Inc.,* 350 F.2d 609 (7th Cir. 1965); *Triangle Publications, Inc.* v. *Standard Plastic Products, Inc.,* 241 F.Supp. 613 (E.D. Pa. 1965); *Fleischmann Distilling Corp.* v. *Maier Brewing Co.,* 314 F.2d 149 (9th Cir. 1963); *S.C. Johnson & Son, Inc.* v. *Johnson,* 266 F.2d 129 (6th Cir. 1959); *Esquire, Inc.* v. *Esquire Slipper Manufacturing Co.,* 243 F.2d 540 (1st Cir. 1957); *Hanson* v. *Triangle Publications,* 163 F.2d 74 (8th Cir. 1947); *Standard Oil Co. of New Mexico* v. *Standard Oil Co. of Cal.,* 56 F.2d 973 (10th Cir. 1932).

Even if it is assumed that the trademark AUDITOR'S has, in fact, acquired secondary meaning and is incontesta-

9. In finding no likelihood of confusion as to source and sponsorship, the Ninth Circuit necessarily reached a determination with respect to each of the foundational factors required in determining whether or not likelihood of confusion exists.

ble and valid the conclusion of the Ninth Circuit would be the same—Bic's use of the legend "Auditor's Fine Point" would not likely cause confusion in the general consumer and commercial market. The incontestability of Lindy's trademark AUDITOR'S did not affect the analysis of the facts relating to likelihood of confusion. Incontestability is not, *in and of itself,* conclusive on the issue of infringement. As the Ninth Circuit correctly recognized at A13:

> "There can be no liability for trademark infringement, even where a mark has attained incontestable status, in the absence of likelihood of confusion."

See also Henri's Food Products Company, Inc. v. *Kraft Inc.,* 717 F.2d 352 (7th Cir. 1983); *Hyatt Corporation* v. *Hyatt Legal Services,* No. 82-C-6178, slip op. (N.D. Ill. April 5, 1983); *Beer Nuts, Inc.* v. *Clover Club Foods Company,* 711 F.2d 934 (10th Cir. 1983); *Johnson Publishing Co., Inc.* v. *Etched-In-Ebony, Inc.,* 213 U.S.P.Q. 994 (D.D.C. 1981); *Armstrong Cork Co.* v. *World Carpets, Inc.,* 198 U.S.P.Q. 526 (N.D. Ga. 1977); *Exquisite Form Industries, Inc.* v. *Exquisite Fabrics of London,* 378 F.Supp. 403 (S.D.N.Y. 1974); *Ye Olde Tavern Cheese Products, Inc.* v. *Planters Peanuts Div.,* 261 F.Supp. 200 (N.D. Ill. 1966), *aff'd,* 394 F.2d 833 (7th Cir. 1967); *Sun-Maid Raisin Growers of California* v. *Sunaid Food Products, Inc.,* 356 F.2d 467 (5th Cir. 1966).

B. Consolidation With *Park 'N Fly* Is Academic

There is obviously a conflict between two federal forums, the Ninth Circuit and a First Circuit District Court with respect to the validity and enforceability of the identical trademark, PARK 'N FLY, as affected by the "incontesta-

bility" statutes, 15 U.S.C. §§1065 and 1115. One forum holds that if a mark becomes incontestable, such fact may be affirmatively asserted in an infringement action and if the indicia of infringement, likelihood of confusion, is present, the mark should be enforced. *Park 'N Fly, Inc.* v. *Park & Fly, Inc.*, 489 F.Supp. 422 (D. Mass. 1979). The other forum, *Park 'N Fly, Inc.* v. *Dollar Park and Fly, Inc.*, 718 F.2d 327 (9th Cir. 1983), held that the mark was invalid and the evidence was sufficient to cancel the mark except for its incontestable status. The Court accordingly refused to enforce the mark in an infringement action and did not consider the likelihood of confusion issue since its disposition of the incontestability issue made it unnecessary to reach the question of infringement. *Id.* at 331-32 n.4.

The Petitioners have attempted to bootstrap the present case into the *Park 'N Fly* case now before this Court, by a claim that the pivotal issue is incontestability, as it appears to be in the *Park 'N Fly* case. It is plain that this is a subterfuge.

Whatever the Ninth Circuit view on incontestability is, as an offensive or defensive medium, one thing is plain. That view played no part in the decision of this case, which was determined on the finding or assumption that the trademark was in fact valid and enforceable but *as a matter of fact not infringed.*

In these circumstances, it would not serve the purposes of this Court's adopted standards for the exercise of its prerogative of certiorari, to grant the Petition in this case, when this case does not present the issue to which this Court has elected to direct its attention and when a review would serve no purpose in the ultimate determination of this case.

The Petition should plainly be denied and the suggestion by Petitioners to consolidate or stay this case is not only without merit but is, in fact, academic. The suggestion could only have been made in furtherance of Lindy's effort to relate its case to *Park 'N Fly* and thereby breathe some relevancy into its Petition.

VII. Conclusion

For the foregoing reasons, the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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